

REMARKS

This Reply is responsive to the final Office Action¹ of June 9, 2010. Claims 1-7 and 9-18 were presented for examination and stand rejected. Claim 16 is canceled and claim 8 was previously canceled, both without prejudice or disclaimer; claims 1, 9, 11 and 17 are in independent form; claims 1-7, 9-15 and 17-18 are pending.

Claims 1, 9, 11, 16 and 17 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claim 16 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1-7, 9, 12 and 18 are rejected under 35 U.S.C. § 103 (a) as allegedly being un-patentable over Burnstein et al. (U.S. 2002/0032735 A1; hereinafter "Burnstein") in view of Munsil et al., U.S. Patent 5,761,650 (hereinafter, "Munsil"), and further in view of Quach (U.S. 2004/0080534 A1; hereinafter, "Quach") and further in view of newly applied Official Notice.

Claims 11 and 13-15 are rejected under 35 U.S.C. § 103(a) as allegedly being un-patentable over Burnstein in view of Quach and further in view of newly applied Official Notice.

Claims 10 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being un-patentable over Burnstein in view of Munsil in view of Quach and further in view of Carter et al. (U.S. 2005/0068983 A1; hereinafter "Carter") and further in view of newly applied Official Notice.

Claim 16 is rejected under 35 U.S.C. § 103(a) as allegedly being un-patentable over Burnstein in view of Munsil.

These rejections are respectfully traversed.

35 U.S.C. §112:

Claims 1, 9, 11, 16 and 17 are rejected under 35 U.S.C. § 112 first paragraph as allegedly failing to comply with the written description requirement. Claim 16 has been canceled without prejudice or disclaimer and its 35 U.S.C. §112 rejection is moot.

The Office Action alleges that "a generated status message is sent to only a specified group; however, such subject matter was not described in the specification..." (Office Action,

¹ The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement.

pg 2) Applicant respectfully disagrees. For example, claim 1 recites, *inter alia*: “sending by operation of said computer a generated status message to only said other customers...” The Examiner apparently contends that “only said other customers” is a specified group which was not described in the specification, but that is not the case. For example, in paragraph [0034] of Applicant’s specification it says, *inter alia*, “The status message may be sent to customer 106A as confirmation that he has successfully joined the group, or it may only be sent to those persons already associated with the COI in order to let them know that a new member has joined the group.” (emphasis added) Clearly, “only...those persons already associated with the COI” appears in the specification and is the specified group which the Examiner alleges is not in the specification. Because this specified group is expressly identified in the specification, the 35 U.S.C. §112 rejection, first paragraph of pending independent claims 1, 9, 11 and 17 is overcome and the rejection should be withdrawn.

Claim 16 is rejected under 35 U.S.C. §112, second paragraph, but this rejection is mooted by the cancellation of claim 16.

Independent claim 1

Claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Munsil and further in view of Quach and further in view of Official Notice. Claim 1 recites, *inter alia*:

“sending, by operation of said computer, a generated status message to only said other customers, if said COI exists, as confirmation that said one customer has joined said COI;” (emphasis added)

The Office Action admits “Burnstein fails to expressly disclose generating and sending a status message to *only* said certain customers as confirmation that said at least one inquiring customer has joined said COI.” (Office Action, ¶ 14, pg 5, emphasis in original) Applicant submits that Burnstein not only fails to expressly disclose that status message, but fails, without qualification, to disclose that status message.

The Examiner then relies upon Quach and newly -applied Official Notice to make up for this admitted deficiency of Burnstein: “However, Quach discloses generating a message to current members regarding a new member to a community/group (Para 0143-0144, Fig. 13A) and Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the new user would not need to receive the message - as

they would already be aware that they joined the group.”² (Office Action, ¶14, pg 5) Applicant respectfully disagrees with the application of Quach and this Official Notice against claim 1 and the other claims for reasons presented below. But, *arguendo*, even if such Official Notice were valid and combinable with Quach, there still would be a deficiency in the Burnstein/Quach/Official Notice combination relative to Applicant’s claim 1. The Official Notice attempts to address only the new member deficiency (relative to the claims) in Quach. But, there is a further teaching (deficiency) in Quach that non-members are also notified and this further teaching (deficiency) prevents the Burnstein/Quach/Official Notice combination from making obvious the subject matter of Applicant’s claim 1.

Consider Quach paragraph [0143], cited by the Examiner, which provides:

[0143] FIG. 19 is a screen shot of an exemplary embodiment user-interface 210 for podium messaging. Using podium messaging, a user can post an instant message for other users. The users for whom the instant message is posted may belong to one or more forums. A podium message is an instant message for all users who are currently browsing the website or are currently logged onto a system incorporating podium messaging. A system administrator may choose to allow whether a non-member can view the podium message. (emphasis added)

Quach paragraph [0143] clearly says that a system administrator may choose to allow non-members of the group to view the podium message. Thus, Quach teaches that its welcoming announcement, made by way of its podium messaging technique, not only is directed to group members, but is also directed to non-group members under a system administrator’s discretion. Indeed, as the system administrator allows non-members to view the podium message, as taught by Quach, the podium message is not sent to only the members (customers).³ Therefore, the Burnstein, Quach, Official Notice and Munsil combination does not disclose or suggest: “sending, by operation of said computer, a generated status message to only said other customers, if said COI exists, as confirmation that said one customer has joined said COI” as recited in claim 1. (emphasis added) Thus, a prima facie case of obviousness has not been

² Munsil, cited for disclosing the tracking of customer billing information and account information, is irrelevant to the status message issue.

³ This was explained in the last response filed March 9, 2010: “In sum, Quach teaches that a welcoming member sends an instant message about the newest member who has joined the site last to ALL members which necessarily includes that newest member (not to mention the fact that Quach also sends the message to non-members via the system administrator). Applicant’s claim 1 clearly avoids Quach because (1) the claim excludes the newest member from receiving that status message and (2) the claim excludes non-members from receiving that status message while Quach teaches the opposite.” (Remarks, March 9, 2010, pgs 13-14)

established. For this reason alone, the 35 U.S.C. §103(a) rejection of claim 1 should be withdrawn and the claim allowed.

Furthermore, Applicant contends the alleged Official Notice taken is not valid or effective in combination with Quach. First of all, the only confirmation that the customer has joined the COI, expressly recited in claim 1, is the recited status message. There is nothing else recited in the claim that expressly confirms that the customer has joined the group. Although the one customer and the other customers in “said subset comprising said one customer and said other customers” as recited in claim 1 communicate “with each other using said domain” as recited in claim 1, that language, by itself, is not confirmation of a legitimate entry into (joining) a particular group in every instance. Hackers do exist in the world. Someone might gain entry to that domain and to that COI group by a nefarious pathway. Thus, contrary to the alleged Official Notice, mere participation by a new party with the group does not necessarily provide the new party with a status message equivalent confirming acceptance of that new party. Accordingly, the alleged Official Notice that such new party knows he/she has joined the group merely because that party is participating is not “capable of such instant and unquestionable demonstration as to defy dispute” (see: MPEP 2144.03A). Therefore, Applicant traverses the Examiner’s Official Notice and, per 37 C.F.R. 1.104(d)(2), requests an affidavit from the Examiner to prove that mere participation with the group inherently means awareness of actually joining the group in every instance, particularly if such participation was achieved by other than an authorized entry to the group.

Moreover, Quach does not lend itself to combination with any reference which teaches that a status message can be withheld from the new gay member, whether a defacto reference or proxy reference via official notice. Quach says: “Be a friendly neighbor and help welcome Craigay2000 in 585 area who joined us on 5/5/2003.” (Quach, Fig. 13A) In other words, this message asks all members and anyone else who receives this message to send a message to the new gay member to welcome him to the group. In this case, the new member may receive multiple “status” messages from multiple group members. Moreover, this welcoming message, or a similar one, appears in no fewer than twenty-four (24) screen-shot Figs. in Quach, namely: Figs. 7A-7G, 8, 10D, 10F, 11A-11C, 12A-12B, 13A-13E, 14-17 and 19! Applicant submits that the appearance of this message in so many Figs. of Quach reinforces Applicant’s position that a fundamental purpose of Quach is to reach out and welcome the new gay man to its group with

this “status” message. Thus, the Examiner’s alleged Official Notice that suggests foreclosing such welcome message to the new member simply is teaching opposite to what Quach is all about and teaches away from Quach, wherefore Quach and this particular Official Notice are not combinable in the first instance.

Finally, Applicant notes for the record that the taking of Official Notice in final office actions, as in this instance, is supposed to be a “rare” event. See MPEP 2144.03A: “While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection....”

Thus, for all of the reasons given above, a prima facie case of obviousness has not been established and the 35 U.S.C. §103(a) rejection of claim 1 should be withdrawn and the claim allowed.

Dependent claims 2-7 and 18 are likewise allowable, at least for reasons based on their respective dependencies from an allowable base claim.

Independent claim 9:

Claim 9 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Munsil and further in view of Quach and further in view of Official Notice. Claim 9 recites, *inter alia*:

“means for sending a generated status message to only said other customers as confirmation that said one customer has joined said COI” (emphasis added)

Claim 9 is allowable for reasons that are the same as, or similar to, those given above for allowance of claim 1 and the 35 U.S.C. § 103(a) rejection of claim 9 should be withdrawn and the claim allowed.

Dependent claim 10 is also allowable at least for reasons based on its dependency from an allowable base claim.

Independent claim 11:

Claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly un-patentable over Burnstein in view of Quach and Official Notice. Claim 11 recites, *inter alia*:

“wherein said at least one customer of said subset inquires about a community of interest (COI), said COI is determined to exist with certain customers of said subset belonging to said COI, and a status message is generated and sent to only said certain customers as confirmation that said at least one inquiring customer has joined said COI” (emphasis added)

Claim 11 is allowable for reasons that are the same as, or similar to, those given above for allowance of claim 1 and the 35 U.S.C. § 103(a) rejection of claim 11 should be withdrawn and the claim allowed.

Dependent claims 12-15 are also allowable, at least for reasons based on their dependencies from an allowable base claim.

Independent claim 17:

Claim 17 is rejected under 35 U.S.C. § 103(a) as allegedly being un-patentable over Burnstein in view of Munsil in view of Quach and further in view of Carter and Official Notice. Claim 17 recites, *inter alia*:

“sending, by operation of said computer, if said COI exists, a generated status message only to others of said subset who belong to said COI as confirmation that said inquiring customer has joined said COI” (emphasis added)

Carter is cited merely to teach “randomly generating alias identity information for community users (Para 0039).” (Office Action, ¶ 37, pg. 10) Carter is not relevant to, and does not teach, the deficiency of the combination of Burnstein, Munsil, Quach and Official Notice relative to the recited claim limitation. Thus, Carter does not cure that deficiency. Therefore, claim 17 is allowable over Burnstein, Munsil, Quach, Carter and Official Notice taken individually or in any reasonable combination for reasons that are the same as, or similar to, those reasons given above for allowability of claim 1.

Independent claim 16 has been canceled without prejudice or disclaimer wherefore the 35 U.S.C. §103(a) rejection of claim 16 is moot.

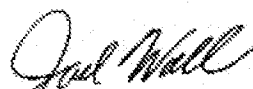
Although Applicant has again focused above on certain limitations that relate to a status message, Applicant does not acquiesce in the rejections presented in the Office Action for other reasons. For example, Applicant believes that Burnstein also fails as an effective teaching reference with respect to Applicant’s recited subject matter because it does not provide a plurality of customers with “a customer profile questionnaire” as recited, for example, in claim 1. Applicant hereby incorporates herein by reference all of its arguments relative to this topic appearing on pages 17-20 in its Remarks filed on March 9, 2010.

CONCLUSION

All rejections in the Office Action have been addressed. In view of the foregoing remarks, reconsideration and allowance of the pending claims are respectfully requested.⁴

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: **August 3, 2010**

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⁴ Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.